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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,799	03/25/2004	Barry J. Lipsky	P68/500578.20072	6031

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REED SMITH, LLP
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599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

TRUONG, THANHNGA B

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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05/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/808,799	LIPSKY ET AL.	
	Examiner Thanhnga B. Truong	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 October 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

*Thanhnga B. Truong
AU2135*

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/13/05
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

1. This action is responsive to the communication filed on March 25, 2004. Claims 1-17 are pending. At this time, claims 1-17 are rejected.

Information Disclosure Statement

2. The information disclosure statement (IDS) filed on January 13, 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro et al (US 7,143,445), and further in view of Chou (US 5,638,444).

a. Referring to claim 1:

i. Ishiguro teaches an electronic reference system comprising:

(1) a portable electronic reference device having memory, a keyboard, a display and a processor (**see Figure 3 and more details on column 7, lines 26-65 of Ishiguro**);

(2) a personal computer having a USB port, a keyboard, a display, memory and a processor (**see Figure 2 and more details on column 6, lines 7-62 of Ishiguro**);

(3) an electric coupling capable of connecting said device to said personal computer through said USB port such that said memory in said device is accessible to said personal computer (**column 7, lines 32-41 of Ishiguro**);

(4) a reference database capable of being stored in memory; said database being encrypted using an encryption key; said encryption key

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being derived from a predetermined value that identifies an authorized location for storing said database (**column 14, lines 33-55 of Ishiguro**); and

(5) wherein said personal computer and said device access said memory of said device only by using authorized software (**column 16, line 64 through column 17, line 10; column 17, lines 26-30 of Ishiguro**).

ii. Although Ishiguro teaches the claimed invention subject matter using encryption key, Ishiguro is silent on the capability of disclosing said encryption key being derived from a predetermined value. On the other hand, Chou teaches this limitation on **column 3, lines 2-13 of Chou**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Ishiguro with the teaching of Chou for providing secure and ciphered communications between any type of computer, including laptops and palmtops (**column 1, lines 5-7 of Chou**).

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Ishiguro with the teaching of Chou to provide a new and improved method and apparatus of providing secure communications between intercoupled computers (**column 1, lines 21-23 of Chou**).

b. Referring to claim 2:

i. The combination of teaching between Ishiguro and Chou teaches an electronic reference system. Chou further teaches:

(1) wherein said predetermined value is a Device Serial Number assigned to said device (**column 3, lines 2-13 of Chou**).

c. Referring to claim 3:

i. The combination of teaching between Ishiguro and Chou teaches an electronic reference system. Chou further teaches:

(1) wherein said predetermined value is a Device Serial Number assigned to said personal computer (**column 3, lines 2-13 of Chou**).

d. Referring to claim 4:

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i. The combination of teaching between Ishiguro and Chou teaches an electronic reference system. Chou further teaches:

(1) wherein said predetermined value is a file system serial number assigned to said memory on said device (**column 3, lines 2-13 of Chou**).

e. Referring to claim 5:

i. The combination of teaching between Ishiguro and Chou teaches an electronic reference system. Ishiguro and Chou further teaches:

(1) wherein said predetermined value is a file system serial number assigned to said memory on said device when said database is the first database stored on said memory (**column 14, lines 33-55 of Ishiguro**); and wherein is a Device Serial Number assigned to said device for any database stored on said memory subsequent to said first database (**column 3, lines 2-13 of Chou**).

5. Claims 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro et al (US 7,143,445), in view of Chou (US 5,638,444), and further in view of Joyce et al (US 6,934,533 B2).

a. Referring to claim 6:

i. The combination of teaching between Ishiguro and Chou teaches an electronic reference system, and Ishiguro further teaches:

(1) wherein said authorized software will derive an encryption voucher from the Device Serial Number assigned to the device on which the database is stored in memory and decrypt said database only if said encryption key matches said encryption voucher (**column 2, lines 21-27 of Ishiguro**).

ii. Although the combination of teaching between Ishiguro and Chou teaches an electronic reference system, however they are silent on the capability of deriving encryption voucher from the Device Serial Number. On the other hand, Joyce teaches this limitation on **column 3, line 45 through column 4, line 11 of Joyce**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

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(1) have modified the combination of teaching between Ishiguro and Chou with the teaching of Joyce for providing secure and ciphèred communications between any type of computer, including laptops and palmtops (**column 1, lines 5-7 of Chou**).

iv. The ordinary skilled person would have been motivated to:

(1) have modified the combination of teaching between Ishiguro and Chou with the teaching of Joyce to provide a new and improved method and apparatus of providing secure communications between intercoupled computers (**column 1, lines 21-23 of Chou**).

b. Referring to claims 7-9:

i. These claims have limitations that is similar to those of claim 6, thus they are rejected with the same rationale applied against claim 6 above.

c. Referring to claim 10:

i. The combination of teaching between Ishiguro, Chou, and Joyce teaches a method for securing digital rights of a database capable of being stored in memory on a portable reference device; said device having a processor, a display and a keyboard, wherein said device is capable of being connected to a PC such that said PC can access said memory in said device, the method comprising the steps of:

(1) encrypting said database with an encryption key (**column 14, lines 33-55 of Ishiguro**);

(2) said encryption key being derived from a file system serial number of an authorized location when said database is the first database stored on said memory; said encryption key being derived from a Device Serial Number of said authorized location when said database is not the first database stored on said memory (**column 3, lines 2-13 of Chou**);

(3) storing said database in memory (**column 14, lines 33-55 of Ishiguro**);

(4) storing said encryption key in a header on said memory associated with said database (**column 14, lines 33-55 of Ishiguro**);

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(5) accessing said database by an authorized software program (**column 16, line 64 through column 17, line 10; column 17, lines 26-30 of Ishiguro**);

(6) reading said header associated with said database to determine the encryption key (**column 14, lines 34-55 of Ishiguro**);

(7) calculating an encryption voucher (**column 3, line 45 through column 4, line 11 of Joyce**);

(8) said encryption voucher being derived from a file system serial number of the memory of the location on which the database is stored when said database is the first database and said encryption voucher being derived from a Device Serial Number of the location when said database is not the first database stored on said memory (**column 14, lines 33-55 of Ishiguro**), (**column 3, lines 2-13 of Chou**) and (**column 3, line 45 through column 4, line 11 of Joyce**);

(9) decrypting said database only if said encryption voucher matches said encryption key (**column 11, lines 1-5; column 15, lines 28-37 of Ishiguro**).

ii. Although Ishiguro teaches the claimed invention subject matter using encryption key, Ishiguro is silent on the capability of disclosing said encryption key being derived from a predetermined value. On the other hand, Chou teaches this limitation on **column 3, lines 2-13 of Chou**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Ishiguro with the teaching of Chou for providing secure and ciphered communications between any type of computer, including laptops and palmtops (**column 1, lines 5-7 of Chou**).

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Ishiguro with the teaching of Chou to provide a new and improved method and apparatus of providing secure communications between intercoupled computers (**column 1, lines 21-23 of Chou**).

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v. Although the combination of teaching between Ishiguro and Chou teaches an electronic reference system, however they are silent on the capability of deriving encryption voucher from the Device Serial Number. On the other hand, Joyce teaches this limitation on **column 3, line 45 through column 4, line 11 of Joyce.**

d. Referring to claim 11:

i. The combination of teaching between Ishiguro, Chou, and Joyce teaches a method for securing digital rights of a database capable of being stored in memory on a portable reference device; said device having a processor, a display and a keyboard, wherein said device is capable of being connected to a PC such that said PC can access said memory in said device, and Ishiguro further teaches:

(1) wherein said PC is connected to said device via a USB port (**see Figure 2 and more details on column 6, lines 7-62 of Ishiguro**).

e. Referring to claim 12:

i. The combination of teaching between Ishiguro, Chou, and Joyce teaches a method for securing digital rights of a database capable of being stored in memory on a portable reference device; said device having a processor, a display and a keyboard, wherein said device is capable of being connected to a PC such that said PC can access said memory in said device, and Chou further teaches:

(1) wherein said encryption key is derived by using a mangling algorithm (**column 3, lines 3-13 of Chou**).

f. Referring to claim 13:

i. The combination of teaching between Ishiguro, Chou, and Joyce teaches a method for securing digital rights of a database capable of being stored in memory on a portable reference device; said device having a processor, a display and a keyboard, wherein said device is capable of being connected to a PC such that said PC can access said memory in said device, and Ishiguro further teaches:

(1) wherein said authorized software program that is accessing said database is installed on the PC (**column 16, line 64 through column 17, line 10; column 17, lines 26-30 of Ishiguro**).

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g. Referring to claims 14-17:

i. These claims have limitations that is similar to those of claims 10 and 2, thus they are rejected with the same rationale applied against claims 10 and 2 above.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Cronic et al (US 7,032,240) discloses a portable authorization device for authorizing use of protected information and associated method (see Title).

b. Rademacher (US 6,804,727 B1) discloses a method for communication from a host computer to a peripheral device (see Title).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

TBT

April 18, 2007

*Thanhnga B. Truong
AU2135*